

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: BRIAN SHUSTER, ET AL.

Serial No.: 09/893,362

Filed: June 25, 2001

Title: METHOD AND APPARATUS FOR  
PROVIDING AUDIO ADVERTISEMENTS IN A  
COMPUTER NETWORK

Art Unit: 3622

Examiner: Donald Champagne

REPLY TO EXAMINER'S ANSWER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir or Madam:

The appellant filed an Appeal Brief in the above-identified application on March 23, 2007 (the "Appeal Brief") to which the Office provided an Examiner's Answer on July 17, 2007 (the "Answer"). The appellant respectfully submits this Reply to the Answer, pursuant to 37 CFR 41.41.

**The Alleged *Prima Facie* Case of Obviousness Is Invalid**

The Answer does not effectively respond to at least two key points made in the Appeal Brief: (1) that both Hamzy and Net-Mercial fail to disclose "delivering said at least one audio advertisement to said at least one user via said network in a format that precludes said at least one user from bypassing playback of any portion of said audio advertisement"; and (2) one of ordinary skill would not have been motivated to make the

proposed combination, because at least one of the references teaches away from the claimed combination. Either one of these points, being not effectively rebutted, should be fatal to the alleged *prima facie* case of obviousness based on a combination of Hamzy and Net-mercial.

1. THE CITED REFERENCES FAIL TO DISCLOSE DELIVERING AN AUDIO AD IN A FORMAT THAT PRECLUDES BYPASSING ITS PLAYBACK

In the Appeal Brief, it was shown that both Hamzy and Net-Mercial fail to disclose:

delivering said at least one audio advertisement to said at least one user via said network in a format that precludes said at least one user from bypassing playback of any portion of said audio advertisement

As defined by independent claims 1 and 17. In the rebuttal presented by the Answer, it was argued that “Hamzy does teach delivering an ad in a format that precludes the user from bypassing the ad (Hamzy, col. 2 lines 25-30)” and that “Net-mercial.com teaches playback of (delivering) an audio ad.” Answer, p. 5 lines 15-17 (emphasis in original). Thus, it is acknowledged that Hamzy fails to disclose delivery of a playable audio ad and Net-mercial fails to disclose delivering an ad in the claimed bypass-precluding format. These acknowledged deficiencies impel the combination argued in the Answer.

However, the argument in the Answer errs by (1) mischaracterizing what is claimed, by (2) resting on an incorrect factual assertion concerning what is disclosed by

Hamzy, and (3) proposing an inoperable combination, i.e., a combination that cannot operate in the claimed manner.

As to the first point, claims 1 and 17 do not define “delivering an ad in a format that precludes the user from bypassing the ad,” as argued in the Answer. Instead, these claims define delivering a playable audio ad in a format that precludes bypassing playback of any portion of the played audio ad. To read on this claim element, there must be an “audio advertisement . . . in a format that precludes said at least one user from bypassing playback of any portion of said audio advertisement.” However, Hamzy discloses only a display ad (and one that permits bypass), and therefore fails to disclose any audio advertisement having the claimed format. Net-mercial discloses an audio ad, but expressly permits bypass and other user controls. Separately, and in combination, Hamzy and Net-mercial fail to disclose delivering an audio advertisement having the claimed format, as explained more fully below and in the Appeal Brief.

As to the second point, the Answer mischaracterizes the disclosure of Hamzy, as must be done if Hamzy is to appear at all relevant to patentability. Hamzy concerns “methods for extending viewing time of advertisements on a client browser.” Col. 1:8-11. None of these methods, however, include precluding bypass of any ad. Instead, Hamzy teaches that extension of viewing time is accomplished by delivering an intervening advertisement, wherein “[w]ithin the display of the advertisement is embedded a randomly placed control function for proceeding from the advertisement to

the web page of interest.” Col. 2:15-19. Therefore, Hamzy teaches delivering an intervening advertisement in which is placed a control function for bypassing the ad after it is displayed to reach originally requested content. In an important sense, this is the opposite of what is claimed.

Moreover, contrary to what is incorrectly asserted in the Answer, Hamzy fails to disclose delivering an ad in a format that precludes bypass of the ad. Hamzy teaches nothing other than delivering ads that include a function for bypassing the ad upon occurrence of a defined event. See, e.g., col. 2:20-29. Indeed, a display ad that could not be bypassed, i.e., one for which bypass is precluded, would be an incredible annoyance. Hamzy does not disclose what the Answer attributes to it, and the asserted *prima facie* case is fatally defective, for this reason alone.

As to the third point, Hamzy and Net-mercial cannot be combined to provide the subject matter defined by independent claims 1 and 17. Hamzy simply fails to disclose anything that can be combined with Net-mercial to obtain the claimed subject matter. If the audio and video ad of Net-mercial is substituted for the static display advertisement of Hamzy, the resulting combination is, in effect, no combination at all, but simply delivery of the audio and video ad that Net-mercial discloses. Both Hamzy and Net-mercial teach providing ads with user controls for bypassing the ad. Indeed, the audio and video ad of Net-mercial suffers from the acknowledged deficiency of not being “in a format that precludes said at least one user from bypassing playback of any portion of

said audio advertisement,” as claims 1 and 17 require. Hamzy teaches bypass of an ad, as shown in the foregoing paragraph.

Therefore, the control feature of Hamzy for permitting bypass of an interstitial display ad could not be grafted onto the audio and video ad of Net-mercial to achieve any useful combination, much less so what is claimed. If a control feature as disclosed in Hamzy were to be included in an audio and video ad as disclosed by Net-mercial, the result would be an audio and video ad that included a “control feature for proceeding from the advertisement to the web page of interest.” Hamzy, col. 2:15-18. Far from resulting in an audio ad formatted to preclude bypassing playback of any portion of the audio ad, such a combination would result in an audio and video ad that is more easily bypassed than not. For this reason as well, no *prima facie* case of obviousness has been made out against independent claims 1 and 17.

2. THE CITED REFERENCES TEACH ONLY THE OPPOSITE OF THE  
PROPOSED COMBINATION AND NET-MERCIAL TEACHES AWAY

It should not be necessary to proceed any further in rebutting the pending rejections, as the deficiencies in the alleged *prima facie* case are glaringly apparent. However, the Answer’s factual assertions that “bypass preclusion is the focus of Hamzy” (Answer, p. 6, lines 5-7) and that Net-mercial teaches a “bypass preclusion option” (p. 6, lines 21-22) mischaracterize the teaching of these references and so warrant rebuttal.

First, as noted above, Hamzy teaches “embedding a randomly placed control function for proceeding from the advertisement to the web page of interest,” i.e., for bypassing the advertisement. Col. 2:16-18. Thus, Hamzy’s function is not bypass preclusion; it is the opposite: providing a bypassing function in an intervening ad. Hamzy therefore teaches only methods that are opposite to what is claimed, as does Net-mercial. Hamzy consistently teaches that an intervening ad is provided with a bypass function. That Hamzy discloses a control function “to display the advertisement . . . for a predetermined time period before transferring the window containing the content or web page the user has selected” (col. 2:25-30) does not alter this conclusion. The function of this timed control is plainly to bypass the displayed ad, so that the selected content can eventually be viewed. Nor can Hamzy’s complaint that “users often bypass advertisements” (see col. 1:64 - 2:1) be used to contradict the plain fact that Hamzy fails to disclose precluding bypass of any portion of a played ad, and instead, only discloses placing a control function in a display ad to allow it to be bypassed whenever the user desires or after a defined period. Col. 2:16-18. This accomplishes Hamzy’s objective of extending the viewing time for ads, but does not amount to precluding bypass of the ad.

In addition, Net-mercial does not teach precluding bypass of an ad. The best that the Answer can muster in support of its untenable position is that Net-mercial teaches that “a timer informs the user that the ad is only temporary.” Answer at p. 6,

lines 20-24, citing Net-mercial at top of p. 2. Informing the user that an ad is only temporary, in fact, does not amount to a disclosure of precluding bypass of any portion of an audio ad. To the contrary, Net-mercial's statement in the very next sentence that "the user can choose, though a series of button bars on the frame . . . to exit the ad" thoroughly vitiates any such premature conclusion. Net-mercial, p. 2, lines 3-6. The simple, plain fact is that Net-mercial fails to disclose any embodiment in which the user is not permitted to bypass any portion of an audio ad.

Furthermore, Net-mercial's statement that the technology gives "the consumer complete control of the ad" demonstrates that Net-mercial teaches away from precluding bypass of any portion of an audio ad. This statement amounts to an implied teaching away from what is claimed. As noted in the article introduced into evidence by the Answer, Teaching A Way Is Not Teaching Away (Barry), "[a] reference may teach away by warning expressly that an element of a claimed invention 'should not, or cannot be used' with the prior art." Barry, p. 870, citing Para-Ordinance Mfg. v. SGS Importers Int'l., 73 F.3d 1085, 1090. In the present application, Net-mercial teaches away by disclosing that

Net-mercials are a simple but highly technical transitional Web advertising solution that occupies the interstitial and intrastitial spaces that occur as a Web site or Web page loads. Each ad maximizes the use of an Internet space and time that is currently void of any consumer experience. Net-mercials currently load in under three seconds, while giving the consumer complete control of the ad.

Net-mercial, p. 1, 2<sup>nd</sup> full paragraph. The claimed element of delivering an ad “in a format that precludes said at least one user from bypassing playback of any portion of said audio advertisement” is logically incompatible with “giving the consumer complete control of the ad.” Furthermore, to address the point raised by the Answer, Net-mercial’s providing of a notice that an ad will expire does not alter this conclusion, and all the more because Net-mercial teaches in the same paragraph that the user can exit the ad at any time. By teaching that the user should be given complete control of the ad and only teaching embodiments consistent with this objective, Net-mercial expressly teaches away from the claimed subject matter.

In addition, Net-mercial may be said to impliedly teach away from claims 1 and 17 also, because the proposed modification “would render inoperable the invention disclosed in the reference.” Barry, p. 872 et seq. That is to say, if Net-mercial were modified such that no portion of its audio and video ads could be bypassed, then it would no longer operate to give the consumer complete control of the ad.

However, that Net-mercial teaches away expressly and/or impliedly is less relevant than the fact that the combination of Hamzy and Net-mercial fails to disclose all elements of independent claims 1 and 17, as discussed in the preceding section. For either of these reasons, the independent claims are allowable. The remaining claims are also allowable, at least as depending from allowable base claims.

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## **Conclusion**

Appellants respectfully request the reversal of the rejection of currently pending Claims 1-33, and allowance of these claims forthwith, for the reasons set forth above and in the Appeal Brief.

Respectfully submitted,

Date: September 17, 2007

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